

REMARKS

Claims 12-32 are now pending in the application. Claim 29 has been amended. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 12-16 and 22-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,475,075 (Wuensch), in view of U.S. Pat. No. 6,244,427 (Syverson). Claims 12 – 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,574,531 (McCurry) in view of U.S. Pat. No. 6,244,427 (Syverson). This rejection is respectfully traversed.

In the most recent Office Action, the Examiner acknowledged that Wuensch and McCurry fail to teach or suggest a motor contained within the driven roller. The Examiner asserts that Syverson cures this deficiency simply through its combination with Wuensch or McCurry.

At the outset, Applicant respectfully submits that the teachings in Syverson directed toward a belt-less conveyor roller are not applicable toward a belt sander. More specifically, Syverson provides drive rollers 20 interspersed on a frame 34 intermediate between one or more like diameter idler rollers 66. The idler rollers 66 are similar in overall construction to the drive rollers 20, except that they do not contain a motor and are not driven. Roller conveyors 21 are designed so that the particular packages, boxes or trays 67 which are moved along the conveyor surface 68 are supported at all times by at least three rollers – either drive rollers 20 or idler rollers 66.

The spacing of the drive rollers 20 is typically such that only one is engaged with a tray 67 at a time. See e.g. Col. 4, Lines 38 – 48; FIG. 1. In this way, the drive rollers 20 are operable to pass an object to an adjacent idler roller or rollers 66 until the object encounters another drive roller 20. The operation of a belt sander requires a drive roller to urge a looped belt, such as sandpaper, in cooperation with a non-driven roller around in a circular pattern.

Further, a frame 34 of Syverson bounds opposite sides of the drive rollers 20 and the idler rollers 66 making unimpeded installation of a looped belt (such as required for a belt sander) around the roller conveyor of Syverson impractical.

A. Improper Combination of References

Additionally, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as required by *Graham v. John Deere Co.*, 148 USPQ 459 (1966) and MPEP § 2141. Specifically, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) *The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*
- (C) *The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and*
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141.01

A. THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION; HOWEVER, NEITHER WUENSCH, MCCURRY NOR

SYVERSON INCLUDES SUCH SUGGESTION OF DESIRABILITY OF THE CLAIMED INVENTION.

Applicant respectfully submits that there is no teaching, suggestion, or motivation set forth in Wuensch, McCurry or Syverson to combine these references to produce the claimed invention. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 (emphasis added); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner is attempting to combine the teachings of the cited references to invent the present invention without any explicit motivation to combine such teachings. The most recent Office Action is completely silent of any recitation that would direct the Applicant to where such motivation can be explicitly found. The Examiner identifies portions of these patents that he relies upon, but fails to provide citations as to where he finds motivation to combine these references. More importantly, Applicant is being denied the opportunity to refute such motivation, since none is identified by the Examiner.

It is readily apparent that neither Wuensch, McCurry nor Syverson provides any teaching, suggestion, or motivation to combine their teachings. Thus, without a teaching, suggestion, or motivation clearly found in within the text of these references, it is improper to combine these references to establish a rejection of obviousness, unless the Examiner can show that such teaching, suggestion, or motivation is generally available in the knowledge of one skilled in the art.

In the absence of any objective evidence or any convincing line of reasoning to combine these references, Applicant respectfully submits that each of the references, either singly or in combination, fail to teach or suggest the claimed invention and, thus, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests reconsideration and withdrawal of the present rejections.

I. A Statement That A Modification Is Well Within The Skill In The Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.

In the most recent Official Action, the Examiner stated that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Wuensch (and/or McCurry) device by replacing the motor with an alternative motor as taught by Syverson which provides an alternative means of powering (the) roller." The Examiner simply picks and chooses among the references elements that allegedly teach the claimed invention. However, the Examiner has failed to show any motivation within these references to make such a combination.

As appropriately stated in MPEP § 2143.01, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis in original); MPEP § 2143.01. That is, it is the Examiner's burden to identify some objective reason to combine the teachings of the references. However, as stated above, the Examiner merely indicated that such

combinations were “obvious”. Therefore, Applicant herein respectfully requests the Examiner to identify some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teaching.

II. The Examiner Must Present A Convincing Line Of Reasoning As To Why The Artisan Would Have Found The Present Invention Obvious.

Since, at this time, the Examiner has failed to provide any objective evidence found in the references to support the combination of these references, the Examiner must present a convincing line of reasoning as to why one skilled in the art would have combined these references. According to MPEP § 2142, it is the Examiner’s initial burden to provide some suggestion of the desirability of doing what the inventor has done. Specifically, “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the absence of any objective evidence or any convincing line of reasoning to combine these references, Applicant respectfully submit that each of the references, either singly or in combination, fail to teach or suggest the claimed invention and, thus, the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the present rejections are respectfully requested.

Applicant submits that claim 29 has been amended to recite a body element having a handle extending in a generally upright orientation. Furthermore, claim 29 has been amended to recite said rotor drum defining a driven roller having a free end and arranged proximate said body element and a belt supported around said non-driven roller and said driven roller, wherein said electric motor is occupies a space defined within a boundary of said belt.

Applicant submits that the art of record fails to teach or suggest such features alone or in combination. Wuensch discloses a hand band sander 10 having a handle 12 on a top side designed approximately in the shape of a strap. A drive 15 comprises an electric motor 16 with gear 17 and serves to drive a sanding band 18 which can be driven in circulating fashion by way of a drive pulley 19 that can be driven in rotary fashion, and a return pulley 20 supported at a distance and which can be driven by way of rotary operation of the drive pulley 19. As depicted in Fig. 2 of Wuensch, the electric motor 16 does not occupy a space defined within a boundary of belt 18.

McCurry discloses a belt sander 10 including hand grips 12 and 13, a housing 14 for an electric motor 15, and a bottom portion 16 with transverse webs 17 and 18 supporting a slightly crowned driven belt roller 19, a slightly crowned idler belt roller 20, and a wear plate. A pinion 25 is journaled in the frame 16 and meshed with gear 24 associated with a belt pulley 26 engaging a belt 27 from a motor pulley 28. The driven roller 19 imparts motion to an endless sanding belt 29 accommodated on rollers 29 and 20. As depicted in Fig 1 of McCurry, the electric motor 15 does not occupy a space defined within a boundary of sanding belt 29. As such, Applicant respectfully submits that claims 12-32 are in condition for allowance.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 9 Aug. 05

By: 

Brian D. Hollis, Reg. No. 51,075
Stephen T. Olson, Reg. No. 36,626

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

BDH:cr